REMARKS/ARGUMENTS

Favorable consideration and allowance of the instant application is respectfully requested in view of the following remarks.

Claims 25-37 are pending in this application.

Favorable consideration and allowance of the instant application is respectfully requested in view of the following remarks.

The Examiner's rejections, as they pertain to the patentability of the claims, are respectfully traversed.

Claims 25-32 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Letton (US 4,713,447). This rejection is respectfully traversed for the following reasons.

Initially, Applicant would like to note that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure [underline emphases added]. See, *Manual of Patent Examining Procedure*, Rev. 3, July 1997, section 2142, pages 2100-108.

Applicant respectfully submits that the Letton reference fails to render the claimed invention prima facie obvious on the grounds that it fails to teach each and every claimed

element thereof. More particularly, whereas the claimed invention requires in step (f) that the glucose sirup/fatty alcohol suspension be dried prior to acetalization, the Letton reference fails to teach, suggest or motivate this claim limitation. The Letton reference, however, teaches in col. 5, lines 23-26, that the homogenized mixture of glucose and a higher alcohol is **only** to be heated (dried) in the event that glucose monohydrate is used. Thus, when a glucose sirup is employed as in the present invention, which is NOT glucose monohydrate, then heating under vacuum is NOT required. However, as is seen by the claimed invention, a drying step is a claim limitation of the present invention when a glucose sirup is used.

It is extremely well settled that one important indicium of non-obviousness is the **teaching away** from the claimed invention by the prior art. See, *In re Braat*, 16 USPQ2d 1812 (Fed. Cir. 1990). Applicant contends that the Letton reference established the non-obviousness of the present invention by teaching away from a heating/drying step when glucose sirup (which is clearly not glucose monohydrate) is used.

As for the limitations contained in Applicant's claims 26-29 and 37, the Examiner has failed to identify where within the Letton reference these limitations are taught and/or suggested. Consequently, Applicant respectfully submits that the Letton reference presumably fails to render these claims prima facie obvious as well.

As for claim 29, the Examiner currently contends that room temperature is "conventionally taken to be 25°C" and, as a result, by Applicant's own definition something at "room temperature" can qualify as being preheated. In response thereto, Applicant respectfully submits that room temperature is conventionally taken to be 20°C, not 25°C. Moreover, when a temperature is not stated could not it also be assumed to be ambient temperature, which clearly is not identical to room temperature. The point is, prima facie obviousness cannot be established based on subjective assumptions, but instead must be

based on facts and technical reasoning. Failure to state a temperature does not constitute facts or technical reasoning, to the best of Applicant's knowledge and understanding.

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 26, 29 and 33-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Letton (US 4,713,447), in view of Grutzke et al. (US 5,648,475). This rejection is respectfully traversed for the following reasons.

The shortcomings associated with the teachings of the Letton reference are as outlined above. The Grutzke reference is cited merely for its alleged teaching concerning the use of a cascade of reactors. However, it is respectfully submitted that regardless of whether the teaching of the Grutzke reference relating to the use of a cascade of reactors is obvious or not, since neither reference, **alone or in combination**, teaches or suggests **all of the claim limitations of the present invention**, a prima facie case of obviousness would nevertheless fail to be established against the claimed invention. See, *MPEP*, section 2142, pages 2100-108.

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

It is believed that the foregoing reply is completely responsive under 37 CFR 1.111 and that all grounds for rejection are completely avoided and/or overcome. A Notice of Allowance is therefore earnestly requested.

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Response dated August 25, 2004
Reply to Office action of June 4, 2004

The Examiner is requested to telephone the undersigned attorney if any further questions remain which can be resolved by a telephone interview.

Respectfully submitted,

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